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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/156,952	09/18/1998	ROY A. OSTGAARD	CYM-025	1770
23639	7590	07/14/2004	EXAMINER	
BINGHAM, MCCUTCHEN LLP THREE EMBARCADERO, SUITE 1800 SAN FRANCISCO, CA 94111-4067			HANDY, DWAYNE K	
			ART UNIT	PAPER NUMBER
			1743	

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/156,952

Applicant(s)

OSTGAARD ET AL.

Examiner

Dwayne K Handy

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 4/12/2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-8,10 and 12-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,12-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Inventorship*

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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3. Claims 1-8, 10 and 12-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodner (5,894,733) in view of Moore (5,855,289). The Examiner is sure applicant is familiar with this rejection at this point since it was originally applied to claims 1-8, 10 and 12-26 and then argued in Office Actions from the previous Examiner as well as in applicant's responses and a Board decision. It is repeated below, however, for applicant's convenience.

Claims 1-8, 10, 12-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brodner (UPS 5,894,733) in view of Moore (USP 5,855,289). Brodner teaches the use of polypropylene (column 3, lines 1 1-13) combination 14 sample vial comprising a sleeve 12 and inner container 10. The combination having an outer surface 55, an open end and closed bottom end (Fig. 2). The vial combination comprising a plurality of integral anti-rotation lugs 56 about the outer surface of the cylindrical body (Figs. 2-3). Wherein the anti-rotation lug comprises a flat, longitudinally disposed surface extending radially outwardly from the body outer surface, which is substantially perpendicular to the body of the vial. Moreover, the surface of the plurality of anti-rotation lugs is accessible when the cap 24 of combination container 14 is engaged with the neck of vial 12 (Fig. 4). Additionally, the lugs have a lowermost edge that is located closer to the open end than to the closed end (Fig. 2). Moreover, Brodner discloses a seal means 32 and 52 disposed between the body and the cap, which seals fluid within the container to assist in long term preservation of contents (Figs. 2-3). Brodner does teach the vial comprising identification markings 72 (column 1, lines 27-42, column 4, lines 4-10). However, Brodner does not specifically recite a first alignment marker on the body on the cap and a second alignment marker on the body, or the cap comprising a torque pattern with a plurality of radially disposed ribs.

Moore teaches a sample vial for use in an automated test apparatus comprising a body with an outer surface, an open end, a closed end, and a cap 34 releasably engagable with the body. The cap comprising an outer surface and a torque pattern (Fig. 1 & 3) on the outer surface, wherein the torque pattern comprising a plurality of radially disposed ribs 64. The vial includes seals 54, 98 disposed between the body and the cap so as to be capable of forming a substantially fluid-tight seal therebetween. Moore teaches the cap comprising first screw threads 62 (Fig. 4) and a second mating screw thread 80 on the body (Fig. 1). Additionally, Moore teaches sample fluid level indicia 108 comprising an upper fill line and a lower 511 line on the outer surface of the vial body (Fig. 1). Moore teaches a first alignment marker 110 on the body on the cap and a second alignment marker 108 on the body (column 7, lines 24-44). Moreover, Moore teaches a proximate structure comprising a storage container and vial sleeve 26 (Figs. 1-2).

Moore teaches the creation of a fluid-tight seal formed between the body and the cap. However, neither Brodner nor Moore disclose the specific range of torque between 5 and 50 inch-pound of torque applied to the cap. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have included in the invention of Brodner and Moore the range of torque between 5 and 50 inch-pound of torque applied to the cap in order to ensure the cap and vial are properly sealed and prevent the leakage of a sample or air from the vial. Further, it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimal or workable ranges involves

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only routine skill in the art. In re Aller, 105 USPQ 233. Accordingly, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the invention of Brodner a first alignment marker on the cap and a second alignment marker on the body, as taught by Moore, in order to insure a fluid-tight seal after a predetermined amount of rotational movement has been achieved between the cap and the vial. Thereby preventing the possibility of damaging the seal by over tightening the cap (column 7, lines 24-34).

### ***Response to Arguments***

4. Applicant's arguments filed 4/12/2004 have been fully considered but they are not persuasive. In attempting to overcome the previous rejections, applicant has amended independent claim 1 and added new claim 27. It appears, however, that in amending claim 1 applicant has actually broadened the claim to now require that only "at least a portion..." of the edge of the "lug" element be perpendicular to the body outer surface. The Examiner believes the previously cited features still provide this feature. This is also the case with new claim 27. It has already been established in previous actions and the Board decision that the snapping together of the specimen and sleeve provides a "body" which meets the limitation of the claim (Board decision, page 8, lines 5-14).

"The appellants argue that the body in their claim 1 is a vial body, whereas Brodner's specimen container and sleeve are separate bodies (reply brief, pages 2-3). A body, the appellants argue, is a "mass of matter distinct from other masses." See *id.* When Brodner's specimen container and sleeve are snapped together (col. lines 6-10 and 22-27) they form a mass of matter distinct from other masses and, therefore, are a body. The appellants argue as though a body must be a single piece having no separable components, which is not correct. An automobile body, for example, is an assembly of a number of parts. Even if Brodner's specimen container and sleeve are considered separate bodies, Brodner would have fairly suggested the appellants' claimed sample vial to one of ordinary skill in the art...."

Therefore, the additional claim 27 is also rejected.

As to applicant's submitted arguments, applicant appears to be arguing that because feature (56) tapers to the surface when meeting the side wall that it is not perpendicular and it would not be obvious to provide this feature (pages 5-7 of applicant's arguments). The fact that element (56) of Brodner may taper down to meet the surface of the side wall does not exclude the element (56) from being perpendicular to the side wall. In fact, the Examiner submits that at the point the element (56) begins to extend from the side wall, it *is* perpendicular to the side wall. The Examiner directs applicant to Figure 3 which clearly shows element (56) extending laterally from the side wall in a perpendicular fashion. This feature was also noted in the portion of the appeal decision which applicant has cited on the bottom of page 6 in the submitted arguments. Therefore, the Examiner believes no finding of obviousness for this particular feature is required – the element (56) is already perpendicular to the wall.

### ***Conclusion***

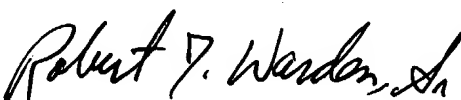
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH  
July 8, 2004

  
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